

REMARKS

Reconsideration of the pending application is respectfully requested in view of the following observations.

1. In the specification

The amendment to the specification is submitted to add appropriate section headings and to remove explicit reference to the claims.

No new matter is entered by way of the amendment to the specification.

Entry of the amendment to the specification is kindly requested.

2. In the claims

Claims 1-3 and 27 have been amended to recite that the value document includes a fourth feature substance where the fourth feature substance is an upgrade of the value document of the series in addition to or instead of the first feature substance.

Support for this amendment can be found at least in paragraph [0019] of the specification.

Claims 10, 11, and 30 have been cancelled without prejudice or disclaimer.

The claims are now considered to be placed in condition for allowance.

No new matter is introduced via the amendment to the claims.

Entry of the amendment to the claims is kindly requested.

3. Rejection of claims 1-10 and 13-43 on the ground of nonstatutory obviousness-type double patenting

Claims 1-10 and 13-43 were rejected on the ground of nonstatutory obviousness-type double patenting in view of claims 1-8, 10, 12-17, 20, 21, 23, 24, 27-29, 31, 32, 36, 38-40, 42, and 45 of copending Application No. 10/575,080.

For the reasons discussed below, the applicant respectfully traverses the nonstatutory obviousness-type double patenting rejection.

In view of the amendments to claims 1-3 and 27, the claims of the instant application are patentably distinct from the claims of copending Application No. 10/575,080. The claims of Application No. 10/575,080 do not recite a fourth feature

substance which is an upgrade of the value document of the series in addition to or instead of the first feature substance. It would not have been obvious to one of ordinary skill in the art to add the fourth feature substance as recited in claims 1-3 and 27 of the instant application to the claimed subject matter of Application No. 10/575,080.

Accordingly, withdrawal of the nonstatutory obviousness-type double patenting rejection is requested.

4. Objection of claim 1 for informalities

The Office Action suggested that in claim 1 “substances are provided” be changed to “substances provided.” It is submitted that the suggested change is not necessary. Claim 1 recites that the value document of a series has a first feature substance. Claim 1 also recites that the second and third feature substances are provided on the value document substrate in a printing ink jointly.

It appears that the Examiner has read the claims to interpret that the value document has three feature substances provided on the value document substrate. However, the comma after “a first feature substance” in line 3 indicates that the second and third feature substances are the substances being provided on the value document substrate in a printing ink jointly. Further clarification may be found in paragraphs [0055] and [0056] of the specification.

From these observations, removal of the objection to claim 1 is merited.

5. Rejection of claims 1-15, 21-41, and 43 under 35 U.S.C. 102(b) as being anticipated by US 6,530,527 (Ahlers)

In view of the amendment to claims 1-3 and 27, it is submitted that the claims are in condition for allowance. Moreover, the claims dependent from claims 1 and 27 are likewise in condition for allowance in view of their dependency from one of claims 1 and 27 and their individually recited features.

Claims 1 and 27 recite a value document having at least three different feature substances for the checking of the value document of a series and a fourth feature substance which is an upgrade of the value document of the series in addition to or instead of the first feature substance.

Ahlers teaches a value or security product with luminescent security elements, where the electroluminescent substances are mixed into the deep-engraved intaglio dye used to print the value or security product (see col. 7, ll. 7-13).

The Office Action (on page 4) relies on Fig. 8 to explain that *Ahlers* teaches three different feature substances on a bank note and further notes that *Ahlers* does not teach a fourth feature substance.

Unlike the requirement of amended claims 1 and 27, *Ahlers* does not teach four different feature substances. Claims 1 and 27 now recite the use of four different feature substances wherein the fourth feature substance is used in an upgrade of the value document of the series. On the contrary, *Ahlers* teaches in Fig. 8 the use of the deep-engraved intaglio dye (2) in three locations on the value/security instrument.

It appears that the Examiner has interpreted the three different locations to teach three different feature substances and thus, *Ahlers* cannot teach a fourth feature substance. Following the Examiner's interpretation, *Ahlers* cannot anticipate claims 1 or 27 since *Ahlers* does not teach a fourth feature substance.

Next, *Ahlers* fails to teach that the value document is part of a series where the value document is upgraded with a fourth feature substance. The value/security instrument (1) of *Ahlers* may be a bank note. However, *Ahlers* does not teach that the bank note can be upgraded. The specification merely describes how electroluminescent substances may be used on the bank note. As a result, *Ahlers* does not teach that the value document is part of a series.

Accordingly, *Ahlers* does not anticipate all of the features of amended claims 1 and 27.

Withdrawal of the rejection of the claims in view of the prior art is kindly requested.

6. Rejection of claims 16-20 under 35 U.S.C. 103(a) as being unpatentable over US 6,530,527 (*Ahlers*) in view of US 6,155,605 (*Bratchley*)

Claims 16-20 are dependent from claim 1 and are likewise in condition for allowance for the reasons above in view of their dependency from claim 1 and their

individually recited features. *Bratchley* does not correct the deficiencies of *Ahlers*, as discussed above.

Accordingly, claims 16-20 are patentable at least on the basis of their dependency from claim 1.

Withdrawal of the rejection of the claims in view of the prior art is kindly requested.

7. Rejection of claim 42 under 35 U.S.C. 103(a) as being unpatentable over US 6,530,527 (*Ahlers*) in view of US 6,155,605 (*Bratchley*) and US Publication 2002/0188845 (*Henderson*)

Claim 42 is dependent from claim 1 and is likewise in condition for allowance for the reasons above in view of its dependency from claim 1 and its individually recited features. *Bratchley* and *Henderson* do not correct the deficiencies of the *Ahlers*, as discussed above.

Accordingly, claim 42 is patentable at least on the basis of its dependency from claim 1.

Withdrawal of the rejection of the claims in view of the prior art is kindly requested.

8. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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